

DOCKET NO: 245637US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

TAKASHI TATSUMI, ET AL

SERIAL NO: 10/716,427

FILED: NOVEMBER 20, 2003

FOR: MESOPOROUS SILICA AND PROCESS FOR PRODUCING THE SAME

: EXAMINER: NAGUBANDI, L.

: ART UNIT: 1621

RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

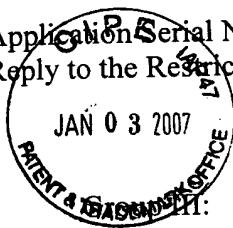
Prior to examination on the merits and in response to the Restriction and Election of Species Requirement mailed on October 2, 2006, Applicants provisionally elect Group III, Claims 8-15, drawn to a process for producing mesoporous silica, with traverse. With the election of Group III, Applicants elect the general method of Claim 8 as the method of producing a particular mesoporous silica, with traverse. Claims 8-15 read on the elected Species, wherein Claims 9-15 are narrower in scope than the general method of Claim 8.

REMARKS

The Examiner is restricting this application to a single group of inventions for further prosecution and is requiring the election of one of the following Groups:

Group I: Claim 1, drawn to a basic silane, classified in class (s) 501, subclass(s) 53;

Group II: Claims 2-7, drawn to mesoporous silica complex, classified in class (s), subclass(s) 53; and



Claims 8-15, drawn to a process for producing mesoporous silica, classified in class 427, subclass 452.

In addition, the Examiner is also requiring an election of a single disclosed Species as follows:

A) If Group II is elected, then elect a single disclosed anionic surfactant, a single disclosed silicate monomer, **and** a single disclosed basic silane;

B) If Group III is elected, then elect a method of producing a particular mesoporous silica.

Applicants provisionally elect Group III, Claims 8-15, drawn to a process for producing mesoporous silica, with traverse. With the election of Group III, Applicants elect the general method of Claim 8 as the method of producing a particular mesoporous silica, with traverse. Claims 8-15 read on the elected Species, wherein Claims 9-15 are narrower in scope than the general method of Claim 8.

Applicants note that the claims of Group III depend directly from the claims of Group II, which in turn depend directly from the claims of Group I. As such, these groups should not be separated.

In regard to Groups I and II, the Office has characterized the relationship between these two pairs of groups as combination and subcombination. Citing MPEP §806.05(c), the Office concludes that the "combination as claimed does not require the particulars of the subcombination as claimed because it is reasonable to assume that any uniqueness in the basic silane compounds will be removed in the process of making the mesoporous silica complex". However, Applicants note that the claims of Group II depend directly from the claims of Group I. Further, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement as the Office merely speculates upon a result and offers no credible support for such an assertion. Withdrawal of the Restriction Requirement is respectfully requested.

In regard to Groups II and III, the Office has characterized the relationship between these two groups as product and process of making the product. Citing MPEP §806.05(h), the Examiner merely alleges that the mesoporous silica can be made by a different method than the process described in the instant invention. However, the Examiner has failed to provide any such “different method”. Therefore, the Examiner has failed to meet the burden necessary to sustain this ground of rejection. Further, the claims of Group III depend from the claims of Group II and, therefore, are should not be separated. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

In regard to Groups I and III, the Office has characterized these groups as being unrelated and cites MPEP §802.01 and §806.06. The Examiner merely alleges that the different inventions of Groups I and III not disclosed as capable of use together and they have different designs. However, the Examiner has merely provided this conclusion and has not provided any support for the same. Further, it is again noted that the claims of Group III depend directly from the claims of Group II, which in turn depend directly from the claims of Group I. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413-2220
(OSMMN 08/03)